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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): UTSD:798US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on May 12, 2006

Signature: Mark Garrett

Typed or printed name: Mark T. Garrett

Application Number	Filed
09/905,670	July 13, 2001

First Named Inventor: Phillip D. Purdy

Art Unit	Examiner
3763	Mark K. Han

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 44,699.
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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May 12, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

Arguments in Support of Pre-Appeal Brief Request for Review for 09/905,670

I. The Anticipation Rejection of Independent Claims 1 and 68 and Their Rejected Dependent Claims over Barbut Has No Factual Support

A. Claim 1

Independent claim 1 is directed to a method of navigating a spinal subarchnoid space in a living being. It comprises:

> percutaneously introducing a guidewire into the spinal subarachnoid space at an entry location;
>
> percutaneously introducing a device over the guidewire and into the spinal subarachnoid space, the device having a first passageway sized to slidably receive, and work with, at least the guidewire, and the guidewire being positioned in the first passageway; and
>
> advancing the device over the guidewire and within the spinal subarachnoid space at least more than 10 centimeters from the entry location.

The Office asserts that this claim is anticipated by Barbut (U.S. 6,379,331) and states that the claimed guidewire is met by needle 66 disclosed in Barbut.

Barbut's needle is not a guidewire by any reasonable standard of claim interpretation. Furthermore, the Office provides no evidence that one of ordinary skill in the art—giving the term guidewire its broadest reasonable interpretation consistent with Applicant's specification—would read the term guidewire broadly enough to cover Barbut's needle. Applicant used the terms "guidewire" and "needle" differently in the application. Specification at page 15, lines 4-27.

For these reasons, the Office has failed to establish a *prima facie* case of anticipation and should withdraw the rejection of claims 1, 4-7, 11-13, 24 and 27.

B. Claim 68

Claim 68 is directed to a method of navigating a spinal subarchnoid space in a living being. It comprises:

> percutaneously introducing a device into the spinal subarachnoid space at an entry location, the device having a first passageway sized to slidably receive, and work with, at least a guidewire;
>
> advancing the device within the spinal subarachnoid space at least more than 10 centimeters from the entry location; and
>
> accessing at least one ventricle located within the head with a second device introduced through the first passageway of the device.

The Office fails to address this claim in its rejection on page 3 of the April 20, 2006 Action, or on pages 6 or 7 of the Action where it addresses Applicant's remarks from the previous response. For this reason alone, the Office has not established a *prima facie* case of anticipation and should withdraw the rejection of claims 68 and 69. Moreover, Applicant explained in section J of the December 22, 2005 Response (pages 13 and 14) why claims 68 and 69 are patentable over Barbut.

II. The Obviousness Rejections of the Dependent Claims Have No Factual Support

A. Claim 2

As explained in Section C of the December 22, 2005 Response, the secondary reference, Michaeli, fails to cure the shortcomings of Barbut and that there is no motivation for the asserted combination. The rejection should be withdrawn.

B. Claim 3

As explained in Section D of the December 22, 2005 Response, the secondary reference, Janese, fails to cure the shortcomings of Barbut. The rejection should be withdrawn.

C. Claims 8, 19 and 20

Applicant directs the panel to its explanation in Section E of the December 22, 2005 Response of why these claims are patentable over the asserted combination. The rejection should be withdrawn.

D. Claims 17 and 22

Applicant directs the panel to its explanation in Section F of the December 22, 2005 Response of why these claims are patentable over the asserted combination. The rejection should be withdrawn.

E. Claim 25

Applicant directs the panel to its explanation in Section G of the December 22, 2005 Response of why this claim is patentable over the asserted combination. The rejection should be withdrawn.

F. Claim 28

Applicant directs the panel to its explanation in Section H of the December 22, 2005 Response of why this claim is patentable over the asserted combination. The rejection should be withdrawn.